

ESTTA Tracking number: **ESTTA704317**

Filing date: **10/23/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202984
Party	Plaintiff Hachette Filipacchi Presse
Correspondence Address	GARY H FECHTER MCCARTER & ENGLISH LLP 245 PARK AVENUE, 27TH FLOOR NEW YORK, NY 10167 UNITED STATES gfechter@mccarter.com, lshyavitz@mccarter.com, apang@mccarter.com, dlynch@mccarter.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Gary H. Fechter
Filer's e-mail	gfechter@mccarter.com, lshyavitz@mccarter.com, apang@mccarter.com, dlynch@mccarter.com, rdesalvo@mccarter.com
Signature	/ghf/
Date	10/23/2015
Attachments	OCTOBER 2015 Hachette Filipacchi Presse v Elle Schneider Trial Brief.pdf(526496 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/240,605  
Filed on February 2, 2011  
Published in the Official Gazette on June 21, 2011  
Mark: ELLE SCHNEIDER

Hachette Filipacchi Presse,	x	
	Opposer,	Opposition No. 91202984
-v-		
Lauren R. Schneider,		
	Applicant.	x

**OPENING BRIEF OF OPPOSER HACHETTE FILIPACCHI PRESSE**

**McCARTER & ENGLISH, LLP**

Gary H. Fechter

Lori Shyavitz

Alice M. Pang

245 Park Avenue, 27<sup>th</sup> Floor

New York, New York 10167

Phone: (212) 609-6800

Fax: (212) 609-6921

*Attorneys for Opposer*

*Hachette Filipacchi Presse*

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## **I. PRELIMINARY STATEMENT**

For seventy (70) years, the world famous ELLE brand, owned by Opposer Hachette Filipacchi Presse (“Opposer” or “Hachette”), has enjoyed extensive use throughout the United States, and for more than fifty (50) years, it has enjoyed registration on the United States Patent and Trademark Office (“PTO”) Principal Trademark Register. The ELLE brand is used and registered in connection with a wide variety of goods and services, including the world’s number one fashion magazine, *ELLE*, the publication of books, entertainment services, namely, providing an online service featuring photographs, and other multimedia materials in the fields of entertainment, music, theater, cinema, literature, arts, and education, apparel, entertainment services, namely, providing an on-line entertainment variety show, DVDs and cosmetics, among others. Indeed, the ELLE mark has been used extensively in connection with entertainment related services and promotions, as a natural extension of its focus on fashion, pop culture, music, film, art and celebrities. Among these many activities, in Fall 2015, Opposer will sponsor its 22nd Annual ELLE Women in Hollywood event, honoring some of the top female film actresses. These events are widely reported in internationally distributed media such as the *Hollywood Reporter*, *Variety*, *Celebrity Gossip*, *The Los Angeles Times*, *The Huffington Post*, *The Denver Post*, YouTube and, of course in *ELLE* magazine and other widely distributed publications and websites. Due to the longstanding and widespread use of the ELLE brand, Hachette’s ELLE marks have become famous, which has been acknowledged by the applicant in this proceeding, the Trademark Trial and Appeal Board (the “Board”) and at least one federal district court.

Applicant Lauren R. Schneider (“Applicant”) has disrupted the ability of Hachette’s ELLE marks to identify and distinguish the goods and services rendered by Hachette. Applicant seeks to register Elle Schneider, a variation of her personal name, as a service mark in

connection with “film and video production; film and video production consulting services; film editing; media production services, namely, video and film production; multimedia entertainment services in the nature of development, production and post-production services in the fields of video and films; multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; photography; photography services; post-production editing services in the field of music, videos and film; production and distribution of videos in the field of fashion; production of films; script writing services; writing of articles for periodicals other than for advertising or publicity; writing of texts other than publicity texts,” in International Class 41, Application Serial Number 85/240,605 (the “Application”).

The Application should be refused registration and this Opposition sustained because Applicant has merely used her personal name to identify herself, and not in connection with rendering the services identified in the Application. Thus, Applicant has not made use of her name as a service mark. Applicant’s personal name is also likely to cause confusion with Hachette’s ELLE marks because Elle Schneider incorporates Hachette’s well-known, famous mark ELLE in its entirety and covers services that are closely related to Hachette’s goods and services, travel through the same channels of trade and are provided to some of the same consumers as the ELLE marks. Registration of Applicant’s proposed mark should also be refused because it is likely to dilute the source identifying function of Hachette’s famous mark ELLE.

## **II. DESCRIPTION OF THE RECORD**

By operation of Trademark Rule 2.122, 37 CFR § 2.122, the Record includes the pleadings in this proceeding, the file history of the Application, and Hachette’s pleaded registrations.

In addition, Hachette offered the following additional evidence during its testimony period and its supplemental testimony period:

- Testimony Deposition of Applicant Lauren R. Schneider, taken on December 26, 2013, with exhibits, filed with Notice of Filing of Certified Deposition Transcript on March 31, 2014 (“Dep. Transcript”);
- Notice of Reliance filed December 26, 2013 (“Notice”) attaching:
  - Exhibit A: Opposer’s First Set of Interrogatories and Document Requests and Applicant’s Responses thereto;
  - Exhibit B: Applicant’s Responses to Opposer’s First Set of Requests for Admission; and
  - Exhibit C: Opposer’s Second Requests for Admission and Applicant’s Responses thereto and accompanying exhibits.
- Second Notice of Reliance filed on March 27, 2015 (“Second Notice”) attaching:
  - Exhibit A: Certificates of Registration for Opposer’s ELLE-formative marks;
  - Exhibit B: Decision issued by the Trademark Trial and Appeal Board in the matter of *Hachette Filipacchi Presse v. Ev International, LLC*, 2008 WL 4233885 (TTAB Sept. 5, 2008) (non-precedential);
  - Exhibit C: Final Judgment entered by the United States District Court for the Southern District of Florida in the matter of *Hachette Filipacchi Presse v. Ricardo Orduz d/b/a ELLAHAIRSTRAIGHTENER.COM*, Civil Action No. 14-cv-20599-UU on April 24, 2014;
  - Exhibit D: Elle.com excerpt accessed on October 4, 2012 at 4:37 a.m., and available at <http://www.elle.com>;
  - Exhibit E: Elleuk.com excerpt accessed on October 4, 2012 at 4:38 a.m., and available at <http://www.elleuk.com/elle-tv>;
  - Exhibit F: Vogue.it excerpt on October 5, 2012 at 10:57 p.m., and available at <http://Vogue.it>;
  - Exhibit G: Opposer’s 2012 Media Kit; and
  - Exhibit H: February 21, 2012 Declaration of Fabienne Sultan Declaration, and exhibits thereto, which was offered in the matter of *Hachette Filipacchi Presse v. Ellebodycare*, Opposition No. 91200547 and assigned Docket Entry Nos. 9 and 10.

Applicant submitted no evidence during either of her trial periods. Likewise, she has not objected to any evidence submitted by Hachette.

### III. STATEMENT OF FACTS

#### A. The ELLE Marks

Since 1945, Hachette, directly and through its predecessors and licensees, has been engaged in the sale of a wide spectrum of goods and services under the mark ELLE, alone or with other words, including, without limitation, the publication, distribution and sale of the world-famous *ELLE* magazine. *See* Hachette's Marks (defined below), including U.S. Reg. No. 0758137, claiming first use in 1945. This magazine is a unique mixture of fashion, beauty, health, entertainment, topical events, and food articles. *See* Second Notice, Exhibit G.

Hachette owns numerous U.S. registrations for marks containing the term ELLE in connection with numerous goods and services, including magazines, for which it has been registered since 1963, as well as other periodicals; forums in the field of fashion and beauty; providing an on-line entertainment variety show, featuring fashion and beauty; and other goods and services, including the following registrations (collectively, hereinafter the "ELLE Registrations," the "ELLE Marks," "Opposer's Marks," or the "Hachette Marks"):

Mark	Reg. No.	Reg. Date	Goods / Services
ELLE	0758137	Oct. 8, 1963	Class 16: Magazines  Date of First Use/First Use in Commerce: Nov. 01, 1945  Affidavit of Incontestability – Accepted
E L L E	1314558	Jan. 15, 1985	Class 16: Stationery-Namely, Notebooks, Writing Pads, Pencils, Notebooks/Writing Pads  Affidavit of Incontestability – Accepted

Mark	Reg. No.	Reg. Date	Goods / Services
ELLE DECOR	1732988	Nov. 17, 1992	<p>Class 16: Magazines featuring interior and exterior decorating, architecture, landscaping, gardening and horticulture; cuisine; art and sculpture, artifacts, antiques and collections, furniture; household accessories, accoutrements, and fixtures; critiques of residences; biographical sketches; electronics for the home; national and international lifestyles, travel, tourism and photography</p> <p>Date of First Use/First Use in Commerce: Oct. 03, 1989</p> <p>Affidavit of Incontestability – Accepted</p>
ELLEDECOR	1668272	Dec. 17, 1991	<p>Class 16: printed matter and periodicals, namely, newspapers, reviews, pamphlets, brochures, newsletters, information or advertising letters, journals and magazines in the fields of interior and exterior decorating, architecture, landscaping, gardening and horticulture; cuisine</p> <p>Class 41: publication of books, magazines, and newspapers</p> <p>Affidavit of Incontestability – Accepted</p>
ELLE	2242315	May 4, 1999	<p>Class 38: Telephone communications services; electronic transmission of data, images and sounds and documents via computer terminals; electronic transmission of information from data banks via computer terminals</p> <p>Class 41: Forums in the field of fashion and beauty; entertainment services, namely, providing an on-line entertainment variety show, featuring fashion and beauty</p> <p>Class 42: Licensing of intellectual property;</p>

Mark	Reg. No.	Reg. Date	Goods / Services
			<p>editing of written texts, book reviews, periodicals, magazines and publications of all types regardless of their form, including electronic and digitalized publications, compiling data bases and data banks for use by others</p> <p>Affidavit of Incontestability – Accepted</p>

Applicant has admitted that Opposer owns the ELLE Registrations. *See* Answer to Amended Opposition, filed February 28, 2013, ¶6. Hachette also owns numerous other registrations for the mark ELLE and other marks that include the term ELLE, in connection with various goods and services. *See* Second Notice, Exhibit A.

All of the ELLE Registrations are valid and subsisting, unrevoked and uncanceled. The ELLE Registrations identified in the chart above are also incontestable and, thus, are prima facie evidence of the validity of Opposer's exclusive right to use the ELLE Marks in commerce in connection with the goods and services described in the registrations, without condition or limitation. The ELLE Registrations thus constitute constructive notice of Opposer's ownership of the ELLE Marks for the goods and services described in the registrations, as provided for by Sections 7(b) and 22 of the Lanham Act, 15 U.S.C. §§ 1057(b) and 1072. *See* 15 U.S.C. § 1065.

*ELLE* magazine was originally published as a French-language magazine distributed in France in 1945 and in the United States since that time. The United States edition of *ELLE* magazine was first published in 1985. *See* Opposer's Marks. At the time Applicant filed the Application, Hachette published *ELLE* magazine in at least 42 separate editions throughout the world. *See* Second Notice, Exhibit H at Ex. 2. Beginning at least as early as 1989, Hachette

also began using the mark ELLE DECOR in connection with a magazine featuring topics such as interior decorating, lifestyle, and various other subjects. *See* Opposer's Marks.

Opposer's *ELLE* magazine is widely circulated (it is the number one fashion magazine in the world) and it has experienced significant sales. For example, Opposer's 2012 media kit indicates that Opposer's magazine experiences 262 million impressions each month. *See* Second Notice, Exhibit G. In addition, in the Spring of 2010 alone, Opposer's *ELLE* magazine reached 6.1 million readers in the U.S. and approximately 23 million readers globally. *See* Second Notice, Exhibit H, ¶7. Between 2007 and 2012, Hachette sold approximately \$900 million worth of ELLE magazines, ELLE-branded cosmetics and related fashion product including ELLE-branded clothing in the United States. *Id.* at ¶19. Opposer's licensed fashion items have generated revenues of over one billion dollars in retail stores within an average of \$650 million dollars annually between 2005 and 2009. *Id.* at ¶15. Between 2007 and 2012, Opposer and its retail partners have spent more than 15 million dollars to promote the sale of ELLE magazines, cosmetics, and fashion products. *Id.* at ¶19. In addition, Opposer and its magazine have won numerous awards, such 2008 Magazine of the Year, awarded by the Accessories Council, three awards for editorial excellence by the Fragrance Foundation in 2011, being selected as 2009's Most Engaged Media Brands, and many others. *See* Second Notice, Exhibit G.

Applicant admits that Opposer's Marks **are famous generally within the fashion industry**. *See* Notice, Exhibit A, Response to Interrogatory No. 18 (emphasis added). Applicant also admits that Opposer's ELLE brand is "long-established" and notes that 322 of the first 500 search results for "ELLE" using the Google.com search engine refer to Opposer's Mark. *See* Notice, Exhibit A, Response to Interrogatory No. 12. She has characterized Opposer's Marks as "numerous" and admits that they are "used broadly in numerous ways." *See* Notice, Exhibit A,



Response to Interrogatory No. 19. In addition to distributing a world famous magazine, Opposer also operates the websites elle.com and ELLE TV. *See* Second Notice, Exhibits D and E; Exhibit H, ¶8. Opposer is a provider of video content, and Opposer's Marks are used in connection with video content for the websites elle.com and Elle TV. *See* Notice, Exhibit A, Response to Interrogatory No. 19; *see also* Second Notice, Exs. D and E. Given the length of time for which Opposer's Marks have been registered and used, Opposer's Marks were famous long prior to the date of the Application and Applicant's alleged first use.<sup>1</sup>

**B. Elle Schneider**

Applicant is an individual named Lauren Schneider. *See* Dep. Transcript, Exhibit 3. On February 11, 2011, Applicant filed a service mark application for "Elle Schneider" (Serial No. 85/240,605) ("Applicant's Mark"). *See id.* Applicant admits that Elle Schneider is a variation of her personal name, Lauren Schneider, using the phonetic spelling of the letter "L." *See* Notice, Exhibit B, Response No. 1; Notice, Exhibit A, Response to Interrogatory No. 2. The application covers the following services in International Class 41:

Film and video production; Film and video production consulting services; Film editing; Media production services, namely, video and film production; Multimedia entertainment services in the nature of development, production and post-production services in the fields of video and films; Multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; Photography; Photography services; Post-production editing services in the field of music, videos and film; Production and distribution of videos in the field of fashion; Production of films; Script writing services; Writing of articles for periodicals other than for advertising or publicity; Writing of texts other than publicity texts

(collectively, the "Applicant's Services"). *See* Dep. Transcript, Exhibit 3. Applicant admits that she did not perform a search for the term ELLE before she filed the Application. *See* Notice, Exhibit A, Response to Interrogatory No. 13.

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<sup>1</sup> In fact, Applicant fails to establish that she has used her name Elle Schneider in connection with the services in United States commerce.

The Application expressly covers services that relate to the magazine publishing and/or fashion industries, including “production and distribution of videos in the field of **fashion**” and “writing of articles **for periodicals** other than for advertising or publicity,” (see Applicant’s Services (emphasis added)), as well as services that the consuming public would expect to see within the pages of a magazine, such as “photography” and “photography services.” *See* Dep. Transcript, Exhibit 3. For example, Applicant admits that in September 2011, her photography was referenced in the *Vogue Italia* website in connection with Vogue’s Fashion’s Night Out exhibition in Milan. *See* Notice, Exhibit A, Response to Document Request No. 2; *see also* Second Notice, Exhibit F.

Applicant alleges in the Application that she has used the name “Elle Schneider” in U.S. commerce as a service mark in connection with all of Applicant’s Services since at least as early as 2006, and she signed the Application under oath attesting to that fact. *See* Dep. Transcript, Exhibit 3. However, when Applicant was questioned about these alleged services, she said that she “used all of them *or [she has] identified [herself] as Elle Schneider with all of them.*” Dep. Transcript at 24:5-10 (emphasis added). Applicant also admitted under oath, however, that she has never used “Elle Schneider” as a service mark in connection with editing services or with “writing of articles for periodicals other than for advertising or publicity.” *Id.* at 27:4-7 and 28:6-24.

Likewise, the evidence demonstrates that Applicant is simply using her personal name only to identify herself as an individual, which is the function of a personal name, and not a service mark. For example, when asked how she provided services in connection with the Elle Schneider “trademark,” Applicant testified that she was hired as a photographer for a web series. *See, e.g., id.* at 24:11–25. Notably, she also characterized photography services as being

“minorly associated” with her work and that she would “not have a problem” removing these services from the application. *Id.* at 25:16-24.

Similarly, Applicant claims that her use of her name “Elle Schneider” in the byline “by Elle Schneider” on unproduced screenplays she has circulated in “the industry” constitutes use of her personal name as a service mark in connection with script writing services and the writing of text. *Id.* at 27:8-23. Yet, Applicant also concedes that her use of her name “Elle Schneider” serves to identify Applicant *as an individual* in these instances. *Id.* at 27:24 – 28:4 (emphasis added). Applicant also admits that she has not used “Elle Schneider” as a service mark in connection with editing services or with “writing of articles for periodicals other than for advertising or publicity,” *see id.* at 27:4-7 and 28:6-24, even though she signed a trademark application under oath attesting to the fact that the “mark” is being used in connection with **all** of the services reflected in the application. Like any other individual, Applicant identifies herself by her personal name, Elle Schneider, when she provides services to customers, and her customers, as well as other people, refer to her as Elle Schneider. *See* Notice, Exhibit B at Response No. 4. Customers and others also refer to her personally as “Elle.” *See* Notice, Exhibit B at Response Nos. 7 and 8.

#### **1. Applicant’s Specimen Does Not Show Trademark Use**

Applicant submitted her business card, which she no longer uses, to the PTO as a specimen to demonstrate her use of “Elle Schneider” as a service mark in connection with the services listed in the Application. *See id.* at 33:12-18. The business card does not include any use of “Elle Schneider” as a service mark. *See id.* Applicant’s business card, like any other business card, merely displays her name, Elle Schneider, in small block letters. *See* Notice, Exhibit C, Response No. 16 and Ex. A. Applicant admits that (i) the name on the business card is “Elle Schneider” and that this name refers to her, (*see* Dep. Transcript at 33:19-23), (ii) the

name “Elle Schneider” on the business card probably could not refer to the services of anyone other than her (*see id.* at 33:24–34:8), (iii) only she carried the business card and that other people who have worked in her “production company” had “their own identification,” (*see id.* at 34:9-11; 34:16-19), and (iv) she has not authorized anyone to use the name “Elle Schneider” in connection with the services identified in the Application (*see* Notice, Exhibit B at Response No. 9).

**2. Applicant’s Other Alleged Uses Of The Name Elle Schneider Do Not Establish Trademark Use**

Applicant admits that she has been the “sole producer” of her goods and services, and that all of the other motion picture production or post-production crew that may have been hired by Applicant or companies collaborating with Applicant are “credited as individuals and not under Applicant’s Mark.” Notice, Exhibit A, Response to Interrogatory No. 10. In fact, Applicant has never authorized anyone else to use the name “Elle Schneider.” *See* Dep. Transcript at 21:22 - 22:3.

When Applicant uses “Elle Schneider” in connection with film or video services, she is referring to herself as an individual. *See id.* at 21:4-8. For example, Applicant admits that when her name appears in film credits, it informs the viewer that Applicant, as an individual, directed the movie. *See id.* at 16:24 – 17:6. She concedes that “directed by Elle Schneider” does not typically mean that another person fulfilled the function of director. *See id.* at 18:18 – 18:21. Applicant also admits that her services are currently provided “via personal interaction” rather than standard trade channels, stores or business locations, and she does not advertise or provide services in such trade channels. Notice, Exhibit A, Response to Interrogatory No. 9. Applicant further admits that her film services “have not been specifically compensated, but rather included in a monthly salary” that encompasses other services, and that during the duration of the case,

she tended to create “personal motion pictures rather than promoting herself for freelance work.” Notice, Exhibit A, Response to Interrogatory No. 6.

Like any other individual using his or her personal name, Applicant uses her name to describe the fact that she is the creator of certain films. *See* Notice, Exhibit C, Response No. 18 and Ex. C. For example, a “mock up” DVD cover for the film “Confession,” which she wrote and directed, describes the movie as “a film **by elle schneider**” under the title of the film, and the back of the case indicates that the film was “written and directed by Elle Schneider.” *Id.* (emphasis added); *see* Dep. Transcript at 19:21-20:4. Indeed, Applicant admits that she did not intend for this to be service mark use. *See* Dep. Transcript 20:13-20:19. Similarly, an advertisement for the film “One Small Step” describes the film as “a film **by elle schneider.**” *Id.* (emphasis added).

Applicant’s alleged “promotional” activities conducted under the “Elle Schneider” name consist solely of “free” advertisements on her production company, Attention Soldier Productions’, website, [www.attentionsoldier.com](http://www.attentionsoldier.com), and business card expenditures, totaling less than \$500. *See* Notice, Exhibit A, Response to Interrogatory Nos. 7 and 8 and Response to Document Request Nos. 9 and 10. This figure includes two iterations of business cards and also includes “website hosting” (presumably relating to the Applicant’s website [www.attentionsoldier.com](http://www.attentionsoldier.com)). Applicant has not advertised in stores, business locations, or publications. *See* Notice, Exhibit A, Response to Document Request Nos. 9 and 10. She admits that she never advertised in print in any manner or performed any traditional advertising and has no current advertising plans. *See* Dep. Transcript at 30:20-31:5; Notice, Exhibit A, Response to Document Request No. 8.

When asked to provide documents sufficient to show all ways in which her mark is displayed to consumers in connection with the advertisement and provision of Applicant's Services, Applicant provided only two documents – a copy of her business card and an excerpt from the Attention Soldier Productions website, [www.attentionsoldier.com](http://www.attentionsoldier.com). *See* Notice, Exhibit A, Response to Document Request No. 6. As discussed above, Applicant's business card, like any business card, displays her name, Elle Schneider. *See id.* at Exhibit C, Response No. 16 and Ex. A; Notice, Exhibit A, Response to Document Request No. 6. In addition, the website excerpt merely identifies Elle Schneider as a Director and Producer at Attention Soldier Productions; it does not reflect use of "Elle Schneider" as a service mark. *See* Notice, Exhibit C, Response No. 17 and Ex. B; Notice, Exhibit A, Response to Interrogatory No. 8.

Applicant also admits that the channels of trade in which her services travel and the consumers of her services overlap with the channels of trade in which Opposer's goods and services travel and Opposer's consumers. *See* Notice, Exhibit A, Response to Interrogatory No. 19. Applicant admits that both parties sell to "traditional consumers" and admits that consumers would encounter video content of both parties online. *See* Notice, Exhibit A, Response to Interrogatory No. 19.

#### **IV. STATEMENT OF THE ISSUES**

The issues to be decided are: (1) whether Applicant's designation "Elle Schneider" is unregistrable because it is merely being used to identify the personal name of an individual performing services, and not as a service mark to identify and distinguish the services rendered by Applicant; (2) whether Applicant's designation "Elle Schneider" is unregistrable because it is likely to cause confusion with Opposer's Marks in the minds of consumers; and (3) whether Applicant's designation "Elle Schneider" is unregistrable because it is likely to cause dilution of Opposer's Marks.

## **V. ARGUMENT**

### **A. Opposer Has Standing To Assert Its Claims**

Hachette has properly made its pleaded registrations of record and has standing to oppose registration of Applicant's Mark, as Hachette would be harmed if Applicant is permitted to register "Elle Schneider" and obtain at least a prima facie exclusive right to use the mark. *See* 15 U.S.C. 1063(a); 15 U.S.C. § 1064; *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028-29 (CCPA 1982); 37 C.F.R. 2.101(b); Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §§ 303.03 and 309.03(b) (2015); *Weider Publ'ns, LLC v. D & D Beauty Care Co., LLC*, 109 U.S.P.Q.2d 1347, 1353 (TTAB 2014) (holding that PTO printouts of opposer's registrations are sufficient to establish standing).

### **B. Opposer's Marks Have Priority**

To establish priority, Hachette must demonstrate proprietary rights in the ELLE mark arising from "a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights." *Herbko Int'l v. Kappa Books*, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002). There is no dispute that Opposer has priority of rights. *See Black & Decker Corp. v. Emerson Elec. Co.*, 84 U.S.P.Q.2d 1482, 1490 (TTAB 2007). Opposer's Marks were registered long before the date the Application was filed on February 11, 2011, and prior to Applicant's alleged first use date of 2006. Indeed, Opposer's earliest application to register ELLE for magazines was filed and registered (as Registration Number 0758137) more than fifty years ago and claims a first use in commerce date of **1945**. Registration Number 0758137 is valid, subsisting and incontestable. *See* Trademark Manual of Examining Procedure, July 2015 ed. ("TMEP") § 206. The other marks asserted by Opposer in its Notice of Opposition were registered in 1985, 1991, 1992, and 1999, respectively, and many of Opposer's other registered marks also pre-date

Applicant's alleged first use date of 2006. *See* Second Notice, Exhibit A. In addition, Applicant concedes that Hachette has priority and that Opposer's ELLE mark is a "long-established brand." *See* Answer to Amended Notice of Opposition, ¶ 8 and Notice, Exhibit A, Response to Interrogatory No. 12.

**C. Applicant's Personal Name Elle Schneider Does Not Function As A Service Mark**

Individuals do not have an absolute right to use and register their personal names as trademarks. There is no provision in the U.S. Trademark Act "which dictates the treatment of given names differently than other marks." *In re Carmine's Broadway Feast Inc.*, 2010 WL 985318, at \*4 (TTAB Feb. 25, 2010) (non-precedential). Where a personal name merely identifies an individual and does not additionally identify and distinguish the services recited, the name fails to function as a service mark. *See* TMEP § 1301.02(b) (citing *In re Mancino*, 219 U.S.P.Q. 1047, 1047-48 (TTAB 1983) (holding BOOM BOOM not registrable because the mark would be viewed by the public as applicant's professional boxing nickname and not as an identifier of service of conducting professional boxing exhibitions); *In re Lee Trevino Enters., Inc.*, 182 U.S.P.Q. 253, 253-54 (TTAB 1974) (application for LEE TREVINO refused because mark was used merely to identify famous professional golfer rather than as mark to identify and distinguish the services rendered by him); *In re Generation Gap Prods., Inc.*, 170 U.S.P.Q. 423, 423-24 (TTAB 1971) (holding that mark GORDON ROSE only identified a particular individual and not as a service mark to identify the services applied for); *see also* TMEP § 1202.09(a) (requiring that the name of a performing artist must be refused registration if the mark is used solely to identify the artist).

Applicant's admissions in this proceeding, including in her discovery responses and other statements she made under oath, demonstrate that to the extent Applicant is using her personal



name in connection with any of the services recited in the Application, she is merely using her “Elle Schneider” name to identify herself as an individual, and not to identify any service that she provides. 15 U.S.C. § 1127 (A “service mark” is defined as “any word, name, symbol, or device, or any combination thereof used by a person ... to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services, even if that source is unknown.”). Applicant’s purported use is thus not use as a service mark, and the Board should refuse registration of the Application.

Moreover, the specimen Applicant submitted with the Application does not demonstrate use of the Elle Schneider name to identify the services rendered by Applicant in commerce. In order for the designation “Elle Schneider” to be registrable as a service mark, the specimen filed by Applicant must demonstrate use of the name in question to identify the services rendered by Applicant, and not merely to identify the particular individual who performs the services set forth in the application. *In re Lee Trevino Enters.*, 182 U.S.P.Q. at 253; *In re Mancino*, 219 U.S.P.Q. at 1047 (“an individual’s name may be registered as a trademark or service mark only if the specimens of use filed with the application demonstrate trademark or service mark use of the individual’s name”).

Applicant’s specimen of record consists solely of a business card, which she admitted under oath that she no longer uses. *See* Notice, Exhibit C, Response No. 16 and Ex. A.; Dep. Transcript at 33:12-18. As Applicant noted, her business card, like any other business card, displays her name, Elle Schneider, but does not include any use of “Elle Schneider” as a service mark. *See* Notice, Exhibit C, Response No. 16 and Ex. A. Further, she admits that only she ever carried the business card and that even other people who have worked in her “production company” had “their own identification.” *See id.* at 34:9-11; 34:16-19. Further, Applicant

admits that she has not authorized anyone to use “Elle Schneider” in connection with the services identified in the Application. *See* Notice, Exhibit B at Response No. 9.

It is clear from the record and a visual inspection of Applicant’s specimen that “Elle Schneider” does not function as a mark to identify and distinguish Applicant’s Services. *Ex parte TOAL*, 111 U.S.P.Q. 450 (Comm’r Pat. & Trademarks 1956), is instructive. In *Ex parte TOAL*, applicant Marguerite Toal filed to register “Marguerite Charlene” in a stylized format as a service mark for the writing of scripts and the composing of songs to be used by others in radio, television and other forms of entertainment. *See id.* at 450. Applicant’s specimens included personal letterheads and business cards, displaying “Marguerite Charlene” and “Scripts and Songs for Radio and Television Performances” with Applicant’s address, an envelope showing “Marguerite Charlene” with the address, and a folder with “Let’s Walk That Mile –Let’s Give that Smile –Words and Music by Marguerite Charlene—Dedicated to ‘My Living Mother,’” with a picture of an elderly woman knitting and the caption “Born February 3, 1861—Charleston, South Carolina,” with a four line verse at the bottom of the page. *Id.* The record also included a picture of a recorded disk that showed “Words—Music—By—Marguerite Charlene.” *Id.*

Registration was refused because the name merely identified an individual rendering personal services and did not function as a mark to identify and distinguish the identified services, and the applicant appealed. *See id.* The Commissioner affirmed the refusal to register, reasoning that the applicant had “adopted and was using the pseudonym or nom de plume of ‘Marguerite Charlene’ to identify herself in connection with song and script writing and possibly with the direction of musical numbers for recording,” but that the record clearly indicated that “Marguerite Charlene” “is a personal name identifying an individual who writes songs and scripts.” *Id.* The Commissioner found that the “fact that it may be an assumed name used only

in connection with her personal services does not alter the fact that it identifies an individual and not a service” and concluded that the alleged mark was used to identify an individual rendering a personal service and not a name adopted and used by applicant to identify and distinguish her services from those of others. *Id.* Like the applicant in *Ex parte TOAL*, Applicant’s specimen is a business card that lists a variation of her personal name, and like the applicant in *Ex parte TOAL*, Applicant’s business card includes limited additional information, consisting of the words “director/writer” in the same size font as “Elle Schneider,” and Applicant’s email address elle@attentionsoldier.com.<sup>2</sup> The specimen must, but clearly does not, “show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant’s services and indicating their source.” TMEP § 1301.04(a); *see also In re Moody’s Investors Serv. Inc.*, 13 U.S.P.Q.2d 2043, 2048-49 (TTAB 1989) (specimen depicting use of “Aaa” was held to identify the applicant’s ratings instead of its rating services).

The limited additional evidence of record here underscores the fact that Applicant’s use of “Elle Schneider” is merely a use of a personal name to identify an individual. For example, the mock-up of the DVD case associated with her films contains “a film **by elle schneider**” under the title of the film, and the back of the mock-up DVD case indicates that the film was “written and directed **by Elle Schneider**.” *See* Notice, Exhibit C, Response No. 18 at Ex. C (emphasis added). Further, Applicant’s website, www.attentionsoldier.com, resolves to the website for Applicant’s production company, Attention Soldier Productions, and identifies Applicant as Director, Producer. *See* Notice, Exhibit C, Response No. 17 and Ex. B. Moreover, Applicant admitted having virtually no advertising expenditures of any kind and no other promotional activities *See* Notice, Exhibit A, Response to Interrogatory Nos. 7 and 8 and

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<sup>2</sup> Attention Soldier is the production company that Applicant founded. *See* Dep. Transcript at 10:24-11:5.

Response to Document Request Nos. 9 and 10; Dep. Transcript at 30:20-31:5; Notice, Exhibit A, Response to Document Request No. 6. These materials, in addition to Applicant's business card, clearly demonstrate that "Elle Schneider" is being used to identify an individual who will perform the services claimed rather than a mark to identify and distinguish services rendered by Applicant. *See In re Generation Gap Products, Inc.*, 170 U.S.P.Q. at 423-24 (finding specimen and other advertising material of record demonstrated that GORDON ROSE designation was "used merely to identify particular individual of that name engaged in the entertainment world" and refusing to register mark); *In re Lee Trevino Enters., Inc.*, 182 U.S.P.Q. at 253 (finding specimens, consisting of publicity posters, brochures and advertising pamphlets, filed with application showed designation "Lee Trevino" was used to identify individual who performs or will perform the services claimed rather than as a mark used to identify and distinguish the services rendered by applicant).

"Elle Schneider" does not qualify as a service mark because it simply identifies the Applicant by name and does not identify any services provided by the Applicant. Because Applicant's Mark does not function as a service mark for the services recited, registration must be refused as required by Sections 1, 2, 3, and 45 of the Trademark Act. *See* 15 U.S.C. §§ 1051, 1052, 1053, and 1127.

**D. Confusion Between Opposer's ELLE Marks And Elle Schneider Is Likely**

Registration of Elle Schneider should also be refused, and this Opposition sustained, because consumer confusion between Elle Schneider and Hachette's well-known ELLE marks is likely. To determine whether a "likelihood of confusion" exists between Hachette's ELLE marks and Applicant's personal name, Elle Schneider, the Board examines the factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973); *see Black & Decker Corp.*, 84 U.S.P.Q.2d at 1490. Those factors are:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods ... described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, i.e. “impulse” v. careful, sophisticated purchasing;
- (5) The fame of the prior mark;
- (6) The number and nature of similar marks in use on similar goods;
- (7) The nature and extent of any actual confusion;
- (8) The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion;
- (9) The variety of goods on which a mark is or is not used;
- (10) The market interface between the applicant and the owner of a prior mark;
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) The extent of potential confusion; and
- (13) Any other established fact probative of the effect of use.

*Majestic Distilling*, 315 F.3d at 1311, 1315, 65 U.S.P.Q.2d at 1201, 1203 (quoting *DuPont*, 476 F.2d at 1361). Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and “any one of the factors may control a particular case.” *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07, 41 U.S.P.Q.2d 1531, 1533 (Fed. Cir. 1997); *see also Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1240, 73 U.S.P.Q.2d 1350, 1353 (Fed. Cir. 2004); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 U.S.P.Q.2d 1557, 1559 (Fed. Cir. 2001).

As discussed further below, the evidence shows that: (1) Hachette's ELLE mark is famous; (2) the ELLE Marks are highly similar in overall commercial impression as "Elle Schneider," (3) the goods and services Hachette provides under the ELLE Marks are, in part identical to, and are otherwise closely related to Applicant's Services and (4) the channels of trade are the same. Thus, Applicant's registration of the personal name Elle Schneider is likely to confuse consumers as to the affiliation or association of Applicant's Services with Hachette's closely related services.

**1. The Fame Factor Dominates The *DuPont* Analysis Because Hachette's ELLE Mark Is Famous**

As the Board has routinely acknowledged, it is appropriate to first analyze the fifth *DuPont* factor concerning the fame of an opposer's mark, because a finding that an opposer's mark is well-known will have a significant impact on the rest of the *DuPont* analysis. *See, e.g., Motion Picture Ass'n of Am., Inc v. Respect Sportwear, Inc.*, 83 U.S.P.Q.2d 1555, 1560 (TTAB 2007); *see also Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 354, 22 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1992) ("In consonance with the purposes and origins of trademark protection, the Lanham Act provides a broader range of protection as a mark's fame grows."). Indeed, fame may be "outcome-determinative in contests as to the likelihood of confusion." *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371, 63 U.S.P.Q.2d 1303, 1308 (Fed. Cir. 2002). As the fame of a mark increases, the degree of similarity between the marks and their goods or services necessary to support a conclusion of likely confusion declines. *See id.* at 1305-6. Determining whether a mark is famous for purposes of the likelihood of confusion analysis requires an assessment along the continuum of a mark's commercial strength, which considers whether the mark has garnered recognition in a "significant portion of the relevant consuming public." *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison*

*Fondee en 1772*, 396 F.3d 1369, 1375, 73 U.S.P.Q.2d 1689, 1694 (Fed. Cir. 2005) (rejecting a “general public” standard for analysis of the *DuPont* famousness factor).

“Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1326-1327, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000) (citing *Kenner Parker*, 963 F.2d at 352, 22 U.S.P.Q.2d at 1455-56). Indeed, the Federal Circuit has stated repeatedly that there is “no excuse” for an applicant “even approaching” a well-known mark. *See, e.g., Nina Ricci, S.A.RL v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 1074, 12 U.S.P.Q.2d 1901, 1903-4 (Fed. Cir. 1989) (quoting *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 924-25, 134 U.S.P.Q. 504, 511 (CCPA 1962)).

Hachette’s ELLE Marks are famous. Hachette’s ELLE mark has been used in commerce for seventy years and registered for over fifty years. Moreover, in *Hachette Filipacchi Presse v. Ev International, LLC*, 2008 WL 4233885 (TTAB 2008) (non-precedential), opposition proceedings involving an intent to use trademark application filed in January 2005, the Board found that Opposer’s ELLE mark was famous and entitled to broad protection. *See id.* at \*3. In reaching its decision, the Board acknowledged that “opposer has extensive sales and readership in connection with the magazine under the ELLE mark” and that the “ELLE mark is broadly connected generally with the fashion industry,” and also noted that the mark “is used with a wide variety of goods and services.” *Id.*; *see also* Second Notice, Exhibits D, E, G, and H. Indeed, as evidenced by Opposer’s 2012 media kit, Opposer’s magazine experiences 262 million impressions each month, (*see* Second Notice, Exhibit G), and in the Spring of 2010 alone, Opposer’s ELLE magazine reached 6.1 million readers in the U.S. and approximately 23 million readers globally (*see* Second Notice, Exhibit H, ¶7). Between 2007 and 2012, Hachette sold

approximately \$900 million worth of ELLE magazines, ELLE-branded cosmetics and related fashion product including ELLE-branded clothing in the United States. *See* Second Notice, Exhibit H, ¶19. Additionally, Opposer’s licensed fashion items have generated revenues of over one billion dollars in retail stores within an average of \$650 million dollars annually between 2005 and 2009. *Id.* at ¶15. Between 2007 and 2012, Opposer and its retail partners have spent more than 15 million dollars to promote the sale of ELLE magazines, cosmetics, and fashion products. *Id.* at ¶19. In addition, Opposer and its magazine have won numerous awards, including but not limited to 2008 Magazine of the Year, awarded by the Accessories Council, three awards for editorial excellence by the Fragrance Foundation in 2011, and selection as 2009’s Most Engaged Media Brands. *See* Second Notice, Exhibit G. Moreover, Applicant herself has admitted that Opposer’s ELLE Marks are famous and therefore has conceded that this factor weighs in favor of Opposer. *See* Notice, Exhibit A, Response to Interrogatory No. 18.

## **2. Hachette’s ELLE Marks And Elle Schneider Are Similar In Overall Commercial Impression**

The similarities of Hachette’s mark ELLE and Applicant’s personal name, Elle Schneider, also favor a finding of likelihood of confusion. Under the first *DuPont* factor regarding the similarity of the parties’ marks in their entireties as to appearance, sound, connotation, and commercial impression, the Board does not make a “side-by-side” comparison. *See Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 108 (TTAB 1975). Rather, the issue is whether the marks are sufficiently similar in terms of their overall commercial impressions such that confusion as to association or affiliation is a likely result. *See San Fernando Elec. Mfg. Co. v. IFD Elecs. Corp.*, 565 F.2d 683, 685, 196 U.S.P.Q. 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 U.S.P.Q.2d 1735, 1741 (TTAB 1991). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific



impression of trademarks. *See Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 U.S.P.Q. 335, 344 (TTAB 1980); *Sealed Air Corp.*, 190 U.S.P.Q.2d at 108.

Here, Applicant has admitted that the ELLE Marks are famous. *See* Notice, Exhibit A, Response to Interrogatory No. 18. In addition, the Trademark Trial and Appeal Board has held that Hachette's ELLE mark is famous. *See Hachette Filipacchi Presse*, 2008 WL 4233885 at \*3. Where, as here, an opposer's marks are famous, the degree of similarity between opposer's and applicant's marks need not be as great as when an opposer's mark is obscure or weak. *See Kenner Parker Toys*, 963 F.2d at 353, 22 U.S.P.Q.2d at 1456. Although there is one difference between the marks at issue here, "a purchaser is less likely to perceive differences from a famous mark." *Id.* "Thus, the argument that an applicant's full name may be perceived as a more specific identification of an individual will be given little weight. . . ." *See Blair Corp. v. Fassinger*, 2008 WL 4674607, at \*11 (TTAB 2008) (non-precedential) ("In light of the fame of opposer's BLAIR mark, applicant's use of the full name MALLORY VALERIE BLAIR may be perceived as a more specific identification of an individual named 'Blair.' Therefore, the addition of the given name MALLORY VALERIE is not sufficient to distinguish the marks."); *Mattel v. S.W. Fransies, Inc.*, 2012 WL 5196153, at \*11 (TTAB 2012) (non-precedential) ("[I]f consumers are not used to seeing opposer's BARBIE linked to a last name, these consumers, upon seeing advertisements for live appearances for BARBIE GRIFFIN might assume that the performances featured opposer's BARBIE. Thus, although applicant's mark includes the term GRIFFIN, when we compare the marks in their entirety we find that on the whole they are similar in appearance, sound, connotation and commercial impression and that the additional wording in applicant's mark is not sufficient to distinguish the marks when used in connection

with related services.”). Given the fame of Opposer’s ELLE mark, consumers viewing “Elle Schneider” are likely to perceive it as a more specific identification of Opposer’s ELLE mark.

Applicant’s inclusion of the descriptive surname Schneider does not minimize the likelihood of consumer confusion because Applicant’s Mark includes the entirety of Opposer’s distinctive and famous ELLE mark. “When one incorporates the entire arbitrary mark of another into a composite mark, inclusion in the composite mark of a significant, nonsuggestive element will not necessarily preclude a likelihood of confusion.” *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022 (C.C.P.A. 1977) (confusion likely between CALIFORNIA CONCEPT and CONCEPT); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 U.S.P.Q. 105 (C.C.P.A. 1975) (confusion likely between BENGAL and BENGAL LANCER). Of course, the addition of a descriptive or suggestive term or otherwise subordinate matter is generally not sufficient to avoid a likelihood of confusion. *Wella Corp.*, 558 F.2d at 1022; *In re South Bend Toy Mfg. Co.*, 218 U.S.P.Q. 479, 480 (TTAB 1983) (confusion likely between LIL’ LADY BUGGY and LITTLE LADY); *Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.*, 253 F.2d 431,432, 117 U.S.P.Q. 213, 215 (C.C.P.A. 1958) (confusion likely between SLIM and VITA-SLIM).

The dominant portion of Elle Schneider is the term “Elle.” The other element in the mark, Schneider, is weak because it is merely a surname, or is otherwise subordinate or secondary. *See* 15 U.S.C. § 1052(e)(4). Further, in considering whether one portion of a mark is most significant in creating a commercial impression, the first portions of marks are likely to be most prominent in the eyes of the consumer. *See Bunte Bros. v. Standard Chocolates, Inc.*, 45 F. Supp. 478, 481 (D. Mass. 1942) (stating “[w]here the only word or first word of a trade-mark is adopted by a competitor, as the first word in its trade-mark, there is more likelihood of confusion

than when second or later words are used,” and finding likelihood of confusion between the marks DIANA and DIANA DEANE); *see also Pikle-Rite Co., Inc. v. Chicago Pickle Co.*, 171 F. Supp. 671, 675 (N.D. Ill. 1959) (stating “[c]ommon experience teaches that an individual will more readily remember the first part of a name than some other part” and finding that defendant’s use of name POL-PAK on pickle bottles infringed plaintiff’s trademark POLKA used to designate varieties of pickles). Here, the first and dominant portion of Applicant’s name is “ELLE,” which is Opposer’s famous mark. *See Hachette Filipacchi Presse*, 2008 WL 4233885, at \*3.

Further, the term “elle” is strong in connection with Opposer’s goods and services because it is at least suggestive if not arbitrary with respect to Opposer’s goods and services. *See Tisch Hotels, Inc. v. Americana Inn, Inc.*, 350 F.2d 609, 611 n.2 (7th Cir. 1965); *see also 2 McCarthy on Trademarks and Unfair Competition*, § 11.11 (4th ed. 2008); TMEP § 1209.01(a). Accordingly, the arbitrary term “elle” is the dominant term in Applicant’s personal name as well as in Hachette’s ELLE marks. Indeed, Applicant admits that the term “elle” is “distinct” and “uncommon” and that customers and other people refer to her as ELLE. *See Notice, Exhibit A, Response to Interrogatory No. 2; see Notice, Exhibit B at Response Nos. 7 and 8.*

Hachette’s mark ELLE and Elle Schneider both contain the visually and aurally identical term ELLE, which is the only term in many of Hachette’s ELLE Marks. Given the dominance of the shared term ELLE and the weakness of the additional term in Applicant’s personal name, the additional element in Applicant’s Mark is insufficient to distinguish the marks. *See Bunte Bros*, 45 F. Supp. at 481; *see also Ex parte The Munising Paper Co.*, 75 U.S.P.Q. 323,323-26 (Comm’r. Pat. 1947) (finding applicant’s mark, “Paragon Precision Made Duplicator Papers”, confusingly similar to the registered mark “Paragon”).

Moreover, Hachette owns registrations for marks that contain the term “elle” along with an additional term or terms, including ELLE DECOR, U.S. Reg. No. 1732988, for magazines, and ELLEDECOR (Stylized), U.S. Reg. No. 1668272, for various printed matter and periodicals, and publication services. *See* ELLE Registrations; *see also* Second Notice, Exhibit A. Consumers are therefore accustomed to seeing goods and services, especially those in the field of fashion and media, sold under marks containing the term “elle” alone and with additional terms, and associating those goods with Hachette. In fact, customers are even accustomed to seeing ELLE with Schneider, as Applicant admits that a Google search of the terms ELLE SCHNEIDER (without quotation marks) reveals among the results a website for Schneider’s Jewelers,” offering Opposer’s ELLE branded jewelry. *See* Notice, Exhibit A, Response to Interrogatory No. 12. Accordingly, consumers are likely to believe that Applicant’s Services offered under a mark containing the term “elle” along with additional terms are associated with Hachette. In addition, Hachette has entered into co-branding and licensing relationships with numerous third parties in the fashion and beauty industries, including Kohl’s, a national department store chain, and Yves St. Laurent. *See* Second Notice, Exhibit H, ¶¶ 12-18. As a result of these relationships, Hachette’s ELLE mark is used in conjunction with various third party trademarks and by itself in connection with a broad range of fashion and media related items.

Finally, the fact that Applicant’s Mark is a personal name does not mean that it should be assessed differently from any other mark. *See In re Carmine’s Broadway Feast Inc.*, 2010 WL 985318, at \*4 (non-precedential). Where the use and/or registration of a junior user’s name as a mark is likely to cause confusion, such use and/or registration must be stopped. *See Mattel*, 2012 WL 5196153 at \*11 (non-precedential); *Jansen Enters. Inc. v. Rind*, 85 U.S.P.Q.2d 1104, 1107-

10 (TTAB 2007) (IZZY’S BROOKLYN BAGELS – KOSHER and Design for restaurant services featuring bagels as a main entrée held likely to be confused with IZZY’S for restaurant services); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 U.S.P.Q.2d 1257, 1260-61 (Fed. Cir. 2010) (“ML is likely to be perceived as shortened version of ML MARK LEES”); *Otto Int’l, Inc. v. Otto Kern GmbH*, 2009 WL 4086580, at \*8 (TTAB 2009) (non-precedential) (finding likelihood of confusion between applicant’s mark, OTTO KERN (stylized with color), and opposer’s OTTO marks). Given the similarities in the marks and the goods and services as discussed herein, Applicant’s Mark is likely to cause confusion with Opposer’s Marks.

### **3. Applicant’s Services And Hachette’s Goods And Services Are Closely Related**

It is well-settled that goods or services need not be identical or even competitive to support a finding of likelihood of confusion. *See, e.g., Hilson Research, Inc. v. Soc’y for Human Resource Mgmt.*, 27 U.S.P.Q.2d 1423, 1432 (TTAB 1993); *In re Int’l Tel. & Tel. Corp.*, 197 U.S.P.Q. 910, 911 (TTAB 1978). Rather, goods or services need only be “related in some manner” or due to “circumstances surrounding their marketing ... they would be likely to be encountered by the same persons in situations that would, because of the marks used thereon, give rise ... to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of “each parties’ goods or services[.]” *Time Warner Entm’t Co. v. Jones*, 65 U.S.P.Q.2d 1650, 1661 (TTAB 2002); *In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (TTAB 1991). In making the requisite assessment of the similarity of the goods and services, the Board is necessarily guided by the parties’ descriptions of their goods and services in their respective applications and registrations. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 2002). “Moreover, the greater the degree of similarity between the applicant’s mark

and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion.” *Time Warner*, 65 U.S.P.Q.2d at 1661.

“[T]he fame of a mark may also affect the likelihood that consumers will be confused when purchasing [products or services]. Indeed, it is precisely these circumstances which demand great vigilance on the part of a competitor who is approaching a famous mark, for ... the lure of undercutting or discounting the fame of a mark is especially seductive.” *Recot*, 214 F.3d at 1327-28, 54 U.S.P.Q.2d at 1897; *see also Anheuser-Busch, Inc. v. Florists Ass’n of Greater Cleveland, Inc.*, 29 U.S.P.Q.2d 1146, 1151 (TTAB 1993) (finding a likelihood of confusion between the parties’ use of the slogan THIS BUD’S FOR YOU in connection with flowers versus beer, in large measure because of the fame of the opposer’s senior use of the mark).

Here, the parties’ services are closely related. Applicant’s Application covers the following services in International Class 41:

Film and video production; film and video production consulting services; film editing; media production services, namely, video and film production; multimedia entertainment services in the nature of development, production and post-production services in the fields of video and films; multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; photography; photography services; post-production editing services in the field of music, videos and film; production and distribution of videos in the field of fashion; production of films; script writing services; writing of articles for periodicals other than for advertising or publicity; writing of texts other than publicity texts.

*See* Applicant’s Application.

Hachette’s Elle Marks are also used to provide services in the fashion and publishing industries, including services relating to videos in the fashion industry, services relating to editing, services relating to periodicals and to other media, *see, e.g.*, Hachette’s Registration No. 2242315 for ELLE, which is made of record, which Applicant admits. *See* Notice, Exhibit A,

Response to Interrogatory No. 19 (admitting that Hachette is a provider of video content). For example, Hachette's Registration No. 2242315 covers "forums in the field of fashion and beauty; entertainment services, namely, providing an on-line entertainment variety show, featuring fashion and beauty" and "editing of written texts, book reviews, periodicals, magazines and publications of all types regardless of their form, including electronic and digitalized publications," all in International Class 41. Applicant acknowledges that Hachette's ELLE Marks are used broadly in numerous ways, including in connection with promotional video content for the website elle.com, for Opposer's *ELLE* Magazine and Hachette's "related brand endeavors." *See* Notice, Exhibit A, Response to Interrogatory No. 19.

Hachette's ELLE Registrations and Applicant's Application also identify goods or services that generally relate to media, writing, periodicals, and other publications. For example, Hachette's ELLE Marks cover magazines, various printed matter and periodicals, and Applicant's Application covers "writing of articles for periodicals other than for advertising or publicity," "writing of texts other than publicity texts," as well as "script writing." Accordingly, Applicant's "Elle Schneider" designation could potentially be used in connection with writing articles that appear in Opposer's publications. Applicant has likewise admitted that Opposer hires photographers like Applicant to provide services. *See* Notice, Exhibit A, Response to Interrogatory No. 19. Indeed, Applicant's photography has been used on the website of the fashion magazine *Vogue Italia*, a competitor of Hachette's *ELLE* magazine. *See* Notice, Exhibit A, Response to Document Request No. 2; *see also* Second Notice, Exhibit F.

Given that the services of the parties are overlapping and closely related, confusion between Opposer's Marks and the Applicant's Mark is likely.

#### **4. The Channels of Trade Are Identical**

Because there are no recited restrictions as to the channels of trade or classes of purchasers with respect to either Applicant's Services or Hachette's goods and services, the Board must assume that these services are available in all the normal channels of trade to all the usual purchasers for such services. *See Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 942, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990); *Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 901, 177 U.S.P.Q. 76, 77-78 (CCPA 1973). As a result, the parties' services are presumed to be marketed to the general public through all normal trade channels, and the channels of trade are thus identical. *See Time Warner Entm't*, 65 U.S.P.Q.2d at 1662.

Applicant also concedes that the channels of trade in which her services travel and the consumers of her services overlap with Opposer's channels of trade and consumers. *See* Notice, Exhibit A, Response to Interrogatory No. 19. Applicant admits that both parties sell to "traditional consumers" and that consumers would encounter video content of both parties online. *See* Notice, Exhibit A, Response to Interrogatory No. 19. Thus, this factor weighs in favor of Hachette.

#### **5. Any Doubt Must Be Resolved In Hachette's Favor**

In balancing the *DuPont* factors, the Board must bear in mind the well-established maxim that any doubts as to the likelihood of confusion must be resolved in favor of the senior mark. *See, e.g., TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 1473, 44 U.S.P.Q.2d 1315, 1318 (Fed. Cir. 1997); *see also Hard Rock Cafe Int'l (USA), Inc. v. Thomas D. Elsea*, 56 U.S.P.Q.2d 1504, 1514 (TTAB 2000) ("[O]ne who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to the likelihood of confusion must be resolved against the newcomer and in favor of the prior registrant."). Based on the foregoing, the Board should conclude that a likelihood of confusion exists under the relevant



*DuPont* factors, and Applicant's Application to register her personal name Elle Schneider should be denied.

**E. Registration Of Elle Schneider Is Likely To Dilute the Famous ELLE Marks**

The Board should also refuse registration of the Application because "Elle Schneider" is likely to dilute the distinctiveness of the famous ELLE mark in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1173 (TTAB 2001). Dilution is defined as the "lessening of the capacity of a famous mark to identify and distinguish goods and services." 15 U.S.C. § 1127; *NASDAQ Stock Mkt. Inc. v. Antartica S.r.l.*, 69 U.S.P.Q.2d 1718, 1733 (TTAB 2003). To prevail on its likelihood of dilution claim, Hachette must show that the ELLE mark: (1) is famous; (2) became famous before the date the Application was filed and any date of use established by Applicant; and (3) Applicant's purported mark "Elle Schneider" is likely to lessen the ability of Hachette's ELLE mark to identify Hachette's goods and services. *Toro*, 61 U.S.P.Q.2d at 1173; *7-Eleven Inc. v. Wechsler*, 83 U.S.P.Q.2d 1715, 1727 (TTAB 2007); *see also* 15 U.S.C. § 1125(c)(1). As discussed more fully below, the evidence presented at trial establishes all three of these elements.

**1. Hachette's ELLE Marks Are Famous And Became Famous Before The Application Was Filed And Any Date Alleged In The Application**

Opposer has established that its ELLE Marks are famous. "[A] mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." 15 U.S.C. § 1125(c)(2)(A). The ELLE mark has been registered in the United States for over fifty years and used throughout the United States for nearly seventy years. For example, *ELLE* magazine is the number one fashion magazine worldwide, and *elle.com* is the number one fashion site worldwide. *See* Second Notice, Exhibit H at Ex. 2.

The evidence supports a finding that the ELLE Marks are famous. Opposer's magazine experiences hundreds of millions of impressions each month, with millions of readers in the U.S. and millions more globally. *See* Second Notice, Exhibit G and Exhibit H, ¶7 (evidencing, in the Spring of 2010 alone, Opposer's ELLE magazine reached 6.1 million readers in the U.S. and approximately 23 million readers globally). In addition, Hachette has sold hundreds of millions of dollars of ELLE magazines, ELLE-branded cosmetics and related fashion product including ELLE-branded clothing in the United States. *See* Second Notice, Exhibit H at ¶ 15 and 19. Opposer and its retail partners have spent millions of dollars to promote the sale of ELLE magazines, cosmetics, and fashion products. *Id.* at ¶19.

Indeed, Applicant herself concedes that Opposer's ELLE Marks are famous. *See* Notice, Exhibit A, Response to Interrogatory No. 18. Applicant admits that Opposer's ELLE brand is "long-established" and notes that 322 of the first 500 search results for "ELLE" using the Google.com search engine refer to Opposer's Mark. *See* Notice, Exhibit A, Response to Interrogatory No. 12. Applicant further notes that Opposer's Marks are "numerous" and are "used broadly in numerous ways." *See* Notice, Exhibit A, Response to Interrogatory No. 19.

The Board, in analyzing the likelihood of confusion factors in another proceeding, has also found that Opposer's ELLE mark is famous, and entitled to broad protection. *See Hachette Filipacchi Presse v. Ev International, LLC*, 2008 WL 4233885 at \*3 (noting Hachette's long and extensive use of ELLE in U.S. commerce in connection with proceedings involving a trademark application filed in January 2005). In addition, at least one federal district court has held that the ELLE trademark is famous. *See* Second Notice, Exhibit C at page 2. Consequently, there is no dispute as to the fame of Opposer's ELLE Marks. There also can be no dispute that Opposer's

ELLE Marks became famous before the application to register Applicant's Mark was filed in 2011.

Opposer's ELLE magazine is widely circulated and it has experienced significant sales, with 262 million impressions each month. *See* Second Notice, Exhibit G. For example, in the Spring of 2010 alone, Opposer's ELLE magazine reached 6.1 million readers in the U.S. and approximately 23 million readers globally. *See* Second Notice, Exhibit H, ¶7. Also in 2010, the English-language edition of ELLE magazine generated more than \$75 million in advertising revenue from operations in the beauty sector. *Id.* at ¶11. Opposer's licensed fashion items have generated revenues of over one billion dollars in retail stores within an average of \$650 million dollars annually between 2005 – 2009. *Id.* at ¶15. Between 2007 and 2012, Opposer and its retail partners have spent more than \$15 million to promote the sale of ELLE magazines, cosmetics, and fashion products. *Id.* at ¶19. In addition, Opposer and its magazine have won numerous awards. *See* Second Notice, Exhibit G.

Moreover, Opposer has diligently policed its marks and has been successful in opposing third party applications to register similar marks and obtaining injunctions against the use of similar marks by third parties. For example, Hachette successfully prevailed upon third parties to abandon, cancel or amend, among others, the following marks containing the word "ELLE" or variations thereon covering a wide range of goods and/or services:

<b>THIRD - PARTY MARKS</b>	<b>APP./ REG. NO.</b>	<b>TTAB PROCEEDING NO. (IF APPLICABLE)</b>	<b>CLASSES</b>
ELLE MEME	3,412,682	92050566	14
ELLE & EMME	3,796,243	91187443	14
ELLE ROSE	77/053,140	91180293	14

<b>THIRD - PARTY MARKS</b>	<b>APP./ REG. NO.</b>	<b>TTAB PROCEEDING NO. (IF APPLICABLE)</b>	<b>CLASSES</b>
ELLE NICOLE	77/856,669	91195956	18
ELLESIO	75/851,096	91120160	14
A.T.ELLE	77/770,573	91194319	25
BEN & ELLE NEW YORK	75/274,842	91111986	25
ELEE	75/712,706	91120086	25
X'ELLE and X'ELLE	75/833,171 and 75/833,169	91120133	18 and 25
EZ ELLE	76/634,363	91175815	31
CHEZ ELLE LINGERIE	78/545,895	91174433	25
LISSA ELLE and LISSA ELLE LE	78/506,397 and 78/506,401	91172837 and 91172820	25
VY & ELLE	76/643,567	91173472	18
MARIEELLE	78/291,698	91164199	18
ELLE & KATIE	75/765,653	91118384	25
DENISE ELLE	74,624,820	91099775	25
ELLE'S LOVE	74/356,917	91093307	25
ELLE JOLEI	85/831,321	91216017	35
ELLE BON	86/002,186	91215564	25
ELLE TIAN	85/926,962	91215243	25
GET ELLE EVATED THE	85/816,158	91212466	35

<b>THIRD - PARTY MARKS</b>	<b>APP./ REG. NO.</b>	<b>TTAB PROCEEDING NO. (IF APPLICABLE)</b>	<b>CLASSES</b>
COMEBACK MOVEMENT			
ELLE DI	85/550,317	91210606	18
PURE ELLE	85/364,832	91210438	11
ELLE JOLIE	85/383,850	91207992	25
EE ELLE & ELLA	85/554,195	91207993	25
ELLE CREE	85/261,511	91207769	25
ELLE MADISON	85/260,509	91206856	41
ELLA	85/240,871	91202179	9
ELLE WEDDING PHOTOGRAPHY	85/114,782	91200683	41
ELLECARE	85/168,279	91200547	3
ELLA	77/393,802	91196175	25
ELLA SPORT	77/247,978	91188459	25
ELLA D.	77/241,222	91187734	25
ELLE ELLE STUDIO	78/152,867	91159963	40 and 41
ELLE BELLE	2,657,739	92042991	25
DE/ELLA	75/783,358	91121497	25
JEUN-ELLE	75/673,191	91117984	3
ELLER	75/735,952	91118063	35
ELLEL	75/235,208,	91111458,	16, 41,

THIRD - PARTY MARKS	APP./ REG. NO.	TTAB PROCEEDING NO. (IF APPLICABLE)	CLASSES
	75/235,384,  75/235,209 and  75/235,210	91111499,  91111459 and  91111460	9 and  42
ELA	74/487,514	91096602	16
ELLA BY: COLLECTION  2000	74/421,310	91096236	3
NEWELLE	74/403,017	91095504	3
ELLA MUJER	74/292,940	91092318	16
ELLA	78/599,518	91170881	28

*See also* Second Notice, Exhibit H, ¶¶24 – 25 and Exhibit 16 attached thereto.

In addition, Hachette has successfully challenged the registration and continued registration of marks containing the word “ELLE” on multiple occasions. *See, e.g.*, Second Notice, Exhibit H, ¶¶24 – 25 and Exhibit 17 attached thereto (successfully opposing registration of the marks ADDITION ELLE (*Hachette v. Addition-Elle, Inc.*, Opposition No. 91074786) and CHEZ ELLE LINGERIE and Design (*Hachette v. Ev Int’l, LLC*, Opposition No. 91174433) and cancelling the registration ELLE BELLE (*Hachette v. Elle Belle, LLC*, Cancellation No. 92042991)).

Further, Hachette has successfully enforced its exclusive rights in the ELLE Marks in United States District Courts against third parties who have used marks that consist of or include the term ELLE. *See, e.g. France Editions & Publ’ns v. Top Rank Apparel, Inc.*, 87 Civ. 4732

(JK) (SDNY 1987); *Hachette v. X-Large*, 01 Civ. 2852 (NRB) (SDNY 2001); *Hachette Filipacchi Presse v. Elle Model, Inc.*, 96-8487-Civ.-RYSKAMP (S.D. Fla. 1996); *Hachette Filipacchi Presse v. Orduz*, 1-cv-20599-UU (S.D.Fla 2014).

**2. Applicant's Personal Name Elle Schneider Is Likely To Lessen The Distinctiveness Of Hachette's ELLE Marks**

"[D]ilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. 15 U.S.C. § 1125(c)(2)(B). Under the Trademark Dilution Revision Act ("TDRA"), Congress has established the following nonexclusive factors for determining the likelihood of blurring in a dilution case:

- (i) The degree of similarity between the mark or trade name and the famous mark;
- (ii) The degree of inherent or acquired distinctiveness of the famous mark;
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark;
- (iv) The degree of recognition of the famous mark;
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark; and
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B); *see also Visa Int'l Serv. Ass'n v. JSL Corp.*, 590 F. Supp. 2d 1306, 1320 (D. Nev. 2008) ("[T]he six factors regarding dilution by blurring are discretionary and nonexclusive.").

Given the degree of similarity in the marks, the strength and distinctiveness of Opposer's ELLE Marks, the fact that Opposer's Marks have been in substantially exclusive use for many years, and have been deemed famous by a federal district court and by the Board in analyzing the

likelihood of confusion factors in a prior proceeding, and that Applicant has admitted that Opposer's ELLE Marks are famous, it is clear that Applicant's use and registration of Applicant's Mark is likely to cause dilution by blurring of Opposer's famous and distinctive ELLE Marks. Thus, the Board should refuse the registration of Applicant's personal name, Elle Schneider.

**a. ELLE And Elle Schneider Are Nearly Identical**

Perhaps the single most important issue in every dilution case after the question of famousness is the degree of similarity of the parties' marks. Under a dilution analysis, Opposer need not establish that the marks are identical; they need only be sufficiently similar. *Nike, Inc. v. Maher*, 100 U.S.P.Q.2d 1018, 1029-30 (TTAB 2011) (finding applicant's mark, JUST JESU IT likely to dilute opposer's mark, JUST DO IT, because upon encountering applicant's mark, consumers will immediately be reminded of opposer's mark and associate the parties' marks); *see also Nat'l Pork Bd. & Nat'l Pork Producers Council v. Supreme Lobster & Seafood Co.*, 96 U.S.P.Q.2d 1479, 1497 (TTAB 2010) (likelihood of dilution found where the applicant's mark, THE OTHER RED MEAT, was found to be "highly similar" to registrant's marks for THE OTHER WHITE MEAT).

As discussed above in Section V(D)(2), Hachette's ELLE Mark and "Elle Schneider" are nearly identical. In fact, the marks are entirely identical but for the addition of Applicant's last name, Schneider.

Moreover, because Hachette's goods and services are closely related to Applicant's Services under its putative mark, the degree of similarity necessary for a finding of dilution between the parties' marks is less than that which would be required for entirely unrelated goods or services. *See Ford Motor Co. v. Lloyd Design Corp.*, 184 F. Supp. 2d 665, 680 (E.D. Mich. 2002) ("The closer the junior user comes to the senior's area of commerce, the more likely it is



that dilution will result from the use of a similar mark.”); *see also Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 218, 51 U.S.P.Q.2d 1882, 1889 (2d Cir. 1999) (affirming an injunction against Nabisco’s use of a fish-shaped cracker under the prior version of the Federal Trademark Dilution Act on the grounds that the cracker was too similar to Pepperidge Farm’s famous goldfish-shaped crackers, even though Nabisco’s crackers had various visual differences and a different context of being packaged with two other animal-shaped crackers).

Because the parties’ marks are sufficiently similar, dilution by blurring is likely.

**b. Hachette’s ELLE Marks Are Inherently Distinctive.**

Dilution by blurring is also likely because the term ELLE is inherently distinctive. “The [dilution] statute is weighted toward a finding of dilution when the famous mark in question is commercially-strong and inherently distinctive.” *Nat’l Pork Bd.*, 96 U.S.P.Q.2d at 1497. “ELLE” is arbitrary or suggests, without describing, an attribute of the goods and services being provided under the mark. *See Tisch Hotels, Inc.*, 350 F.2d 609, 611 n.2 (7th Cir. 1965); *see also 2 McCarthy on Trademarks and Unfair Competition*, §11.11; TMEP § 1209.01(a).

Hachette’s ELLE Marks are also entitled to a legal presumption of inherent distinctiveness because they are registered on the Principal Register without a claim of acquired distinctiveness. *See Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 345, 52 U.S.P.Q.2d 1094, 1098 (2d Cir. 1999); *Tea Bd. of India v. Republic of Tea, Inc.*, 80 U.S.P.Q.2d 1881, 1899 (TTAB 2006); *Equine Techs., Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 545, 36 U.S.P.Q.2d 1659, 1661 (1st Cir. 1995). Likewise, the ELLE Registrations are incontestable, which means they are presumed valid and protectable and cannot be attacked based on descriptiveness. *See Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 205 (1985) (holding that incontestable mark is immune from being attacked as to its distinctiveness).

**c. Hachette's Use Of The ELLE Marks In Connection With Goods And Services Closely Related To Applicant's Services Is Substantially Exclusive.**

Hachette's ELLE marks enjoy substantial exclusive use. The ELLE Registrations are incontestable, which is evidence that Opposer's use of the marks in connection with all of the goods and services listed in those registrations have been substantially exclusive. *See Mark Morris Assocs., Inc. v. Bio Ramo Drug Co.*, 142 U.S.P.Q. 370, 370 (TTAB 1964) (where opposer's registered mark has become incontestable under Section 15 of the Act of 1946, the registration constitutes conclusive evidence of opposer's exclusive right to use said mark on or in connection with the goods listed in the registration). There is no evidence of any actual use in commerce — either at the time alleged in the Application, the time the Application was filed<sup>3</sup> or today — of any party using the same mark or even a similar mark in connection with identical or closely related goods or services, other than Applicant. In addition, to the extent Opposer was aware of third parties adopting similar marks, Opposer successfully prevented those entities from using and registering their marks. *See, e.g., Hachette v. Addition-Elle, Inc.*, Opposition No. 91074786, *Hachette v. Elle Belle, LLC*, Cancellation No. 92042991, *Hachette v. Ev Int'l, LLC*, Opposition No. 91174433); *France Editions & Publications v. Top Rank Apparel, Inc.*, 87 Civ. 4732 (JK) (S.D.N.Y. 1987); *Hachette v. X-Large*, 01 Civ. 2852 (NRB) (S.D.N.Y. 2001); *Hachette Filipacchi Presse v. Elle Model, Inc.*, 96-8487-Civ.-RYSKAMP (S.D. Fla. 1996); and *Hachette Filipacchi Presse v. Orduz*, 14-cv-20599 - UU (S.D.Fla 2014). *See* Second Notice, Exhibit H, ¶¶ 24 – 25 and Exhibit 17 attached thereto. Thus, the long-standing exclusive use of the ELLE Marks suggests that dilution by blurring is likely.

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<sup>3</sup> As set forth in Section V(C) *supra*, Applicant has not established that she has used her personal name as a service mark.

**d. The Degree Of Recognition Of Hachette's ELLE Marks Is High**

As discussed above, Hachette's ELLE Marks are widely recognized by consumers, and Applicant herself admits that Opposer's ELLE Marks are famous. *See* Notice, Exhibit A, Response to Interrogatory No. 18. The Board has also held, in its analysis of the likelihood of confusion factors, that Hachette's ELLE mark is famous and entitled to broad protection. *See Hachette Filipacchi Presse v. Ev. Int'l, Inc.*, 2008 WL 4233885, at \*3. Likewise, the Board acknowledged that "opposer has extensive sales and readership in connection with the magazine under the ELLE mark" and that the "ELLE mark is broadly connected generally with the fashion industry," and also noted that the mark "is used with a wide variety of goods and services." *Id.* Moreover, the extensive readership, circulation, sales, advertising expenditures, and awards also demonstrate that recognition of the ELLE mark is extremely high. *See* Second Notice, Exhibits D, E, G, and H. This substantial degree of consumer recognition suggests that dilution by blurring is likely.

## **CONCLUSION**

The evidence of record demonstrates that Applicant has failed to make use of her personal name as a service mark, Applicant's personal name is likely to cause confusion, mistake or deception as to the source, affiliation or sponsorship of the Applicant's services and Applicant's personal name is likely to blur the distinctiveness of Hachette's famous ELLE Marks. Accordingly, the Board should sustain Hachette's Opposition and refuse the registration of Serial No. 85/240,605 for the personal name Elle Schneider.

Dated: October 23, 2015

Respectfully submitted,

McCARTER & ENGLISH, LLP

By: /Gary H. Fechter/

Gary H. Fechter

Lori Shyavitz

Alice M. Pang

245 Park Avenue, 27<sup>th</sup> Floor

New York, New York 10167

Phone: (212) 609-6800

Fax: (212) 609-6921

*Attorneys for Opposer*

*Hachette Filipacchi Presse*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing OPENING BRIEF OF OPPOSER HACHETTE FILIPACCHI PRESSE has been served by First Class Mail, postage prepaid, on Applicant Lauren R. Schneider at the following address for Applicant:

Lauren R. Schneider  
465 North Summit Avenue  
Pasadena, CA 91103-3719

Date: October 23, 2015

/Alice M. Pang/  
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Alice M. Pang